

Patent Application
Attorney Docket No.: 25092-13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Bichel et al.
Serial No.: 10/067,145
Confirmation No.: 4799
Filing Date: February 4, 2002
For: APPARATUS AND METHOD OF SOFT SORTING
FRUITS AND VEGETABLES
Examiner: Joseph C. Rodriguez
Group Art Unit: 3653

VIA FACSIMILE (703) 872-9306

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Joseph C. Rodriguez

**ELECTION IN RESPONSE TO RESTRICTION REQUIREMENT
AND REQUEST FOR RECONSIDERATION**

Sir:

This is in response to the Restriction Requirement of August 27, 2003 having a period of response as set forth therein of one (1) month. The period for response is hereby extended by five (5) months.

As a preliminary matter, it should be noted that the Restriction Requirement failed to group claims 35 and 36. In a telephone conversation between the Examining Attorney and the undersigned on January 22, 2004, it was indicated that claims 35 and 36 should be included in Group IV.

*Election in Response to Restriction Requirement
and Request for Reconsideration*

Page 1 of 10

Patent Application
Attorney Docket No.: 25092-13

Applicant provisionally elects, with traverse, to have Group I (which includes claims 1-10, 21-29, and 37-43) examined.

The restriction requirement is submitted to be improper for the following two reasons:

(1) The Examining Attorney has failed to meet his initial burden of showing that the four grouped inventions are distinct; and

(2) Examination of the entire application can be made without a serious burden on the Examining Attorney and the Examining Attorney has failed to properly establish that examination of the entire application will result in a serious burden.

Each of these reasons will be discussed below in more detail.

1. The Examining Attorney Has Failed To Meet His Initial Burden Of Showing That The Inventions Are Distinct.

In the restriction requirement, the Examining Attorney grouped the claims into four groups, namely groups I, II, III and IV. Each group includes both apparatus claims and method claims. The Examining Attorney's reasons for holding that the four grouped inventions are distinct are as follows:

(A) With respect to each of the four groups, the Examining Attorney first states that the four grouped inventions

Election in Response to Restriction Requirement
and Request for Reconsideration

Page 2 of 10

Patent Application
Attorney Docket No.: 25092-13

as claimed are related as process and apparatus for its practice. In requiring restriction based on this, the Examining Attorney states that the "method claims as grouped above are distinct from the separately grouped apparatus claims as each respective group of apparatus claims has a materially different feature that can be used to practice the respective process."

The Examining Attorney attempts to quickly and efficiently address restriction between all four groups in a single statement. In doing so, however, he fails to provide any examples that recite the material differences to which he refers. It should be noted that the "burden is on the examiner to provide reasonable examples that recite the material differences." See MPEP § 806.05(e) Given that the Examining Attorney provides no examples that recite material differences, the Examining Attorney's restriction requirement based on the fact that the four grouped inventions as claimed are related as process and apparatus for its practice is improper and should be withdrawn.

It should also be noted that no where in the Restriction Requirement does the Examining Attorney address a reason for requiring restriction between the apparatus claims of Group I and the apparatus claims of Group II. The Examining Attorney only addresses the issue of the apparatus claims in each of these two groups as they relate to the method claims in the other of these two groups. Thus, no rationale is provided to support restricting the apparatus claims of Group I from the apparatus claims of Group II. In the event that the Examining Attorney maintains his restriction requirement with respect to Groups I and II, his requirement should be modified to group the apparatus claims of Group I and Group II together.

*Election in Response to Restriction Requirement
and Request for Reconsideration*

Page 3 of 10

Patent Application
Attorney Docket No.: 25092-13

(B) With respect to the inventions of Group III and IV, the Examining Attorney further indicates that these two inventions are related as subcombinations disclosed as usable together in a single combination. In requiring restriction based on the fact that the two inventions are related as subcombinations disclosed as usable together in a single combination, the Examining Attorney states that "each invention has separate utility as a different method of sorting."

The burden is on the Examining Attorney to provide examples showing that one of the subcombinations has utility other than in the disclosed combination. See MPEP § 806.05(d). Here, the Examining Attorney simply concludes that the separate utility is a different method of sorting without providing any examples of what different method he is referring to. Given that the Examining Attorney fails to provide any examples showing that the subcombinations have utility other than in the disclosed combination, the Examining Attorney's restriction requirement based on the fact that these two inventions are related as subcombinations disclosed as usable together in a single combination is improper and should also be withdrawn.

(C) With respect to Groups I and III, I and IV, II and III, and II and IV, the Examining Attorney further indicates that these inventions are related as combination and subcombination. In requiring restriction based on the fact that these inventions are related as combination and subcombination, the Examining Attorney states that the "subcombinations of a plurality of rotating rollers and a rotating chamber have separate utility as a means for sorting."

*Election in Response to Restriction Requirement
and Request for Reconsideration*

Page 4 of 10

Patent Application
Attorney Docket No.: 25092-13

Once again, the burden is on the Examining Attorney to provide examples showing the separate utility. See MPEP § 806.05(c). The Examining Attorney simply concludes that the subcombinations have separate utility as a means for sorting without providing any examples of what means for sorting he is referring to. Given that the Examining Attorney fails to provide any examples showing separate utility, the Examining Attorney's restriction requirement based on the fact that these groups of inventions are related as combination and subcombination is also improper and should be withdrawn.

2. Examination Of The Application Will Not Result In A Serious Burden On The Examining Attorney AND The Examining Attorney Has Failed To Establish That Such A Burden Will Result.

The restriction requirement is also improper because examination of the entire application can be made without a serious burden on the Examining Attorney. MPEP § 808 states:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections.

See MPEP § 808. MPEP Section 808.02 further states:

*Election in Response to Restriction Requirement
and Request for Reconsideration*

Page 5 of 10

Patent Application
Attorney Docket No.: 25092-13

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field

*Election in Response to Restriction Requirement
and Request for Reconsideration*

Page 6 of 10

Patent Application
Attorney Docket No.: 25092-13

of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

See MPEP § 808.02.

Thus, in order to establish that a serious burden will result if the entire application is examined, it must be shown that:

- (A) separate classification of the grouped inventions is required, or
- (B) the grouped inventions have formed a separate status in the art, or
- (C) a different field of search is required for the different grouped inventions.

In support of his restriction requirements, the Examining Attorney states that the inventions are distinct and

*Election in Response to Restriction Requirement
and Request for Reconsideration*

Page 7 of 10

Patent Application
Attorney Docket No.: 25092-13

further states that "Because these inventions are distinct for the reasons given above and the search required for the groups are different, restriction for examination purposes as indicated is proper." Thus, the Examining Attorney relies solely on a showing under item (C) above to support his position that a serious burden will result if the application is examined in its entirety.

The problem with the Examining Attorney's statement is that it simply restates what the criteria is, namely that a different field of search is required. It does not provide an appropriate explanation, or any explanation for that matter, of why a different field of search is required. As such, it is insufficient to support the restriction requirement and the restriction requirement is improper and should be withdrawn for this reason as well.

Not only did the Examining Attorney fail to establish that a different field of search is required, Applicant argues herein that a different field of search is not required. As a starting point, it should be noted that all of the grouped inventions are directed to either an apparatus or method of sorting a food product or products. Furthermore, by the Examining Attorney's own admission, each of the grouped inventions falls under the same class, namely class 209. Finally, as Applicant argues below, each of the grouped inventions fall under the same subclass, namely subclass 659 of class 209. These factors, combined with the fact that there is no evidence to support a different conclusion, lead one to conclude that a different field of search is not required.

*Election in Response to Restriction Requirement
and Request for Reconsideration*

Page 6 of 10

Patent Application
Attorney Docket No.: 25092-13

One final point. As stated above, Applicant believes that all of the grouped inventions fall indirectly under the same subclass of class 209, namely subclass 659. The Examining Attorney appears to agree with Applicant with respect to the Group I and III inventions. He classifies each of those groups in a subclass that is indented indirectly under subclass 659.

With respect to the Group II and IV inventions, however, the Examining Attorney differs with the Applicant regarding the proper classification of those grouped inventions. The Examining Attorney indicates that the Group II inventions fall under subclass 369 while the Group IV inventions fall under subclass 288. Each of the two subclasses 288 and 369 are, directly or indirectly, indented under subclass 233. Subclass 233 includes

means and methods by which material is separated or assorted according to size or dimensions of components by presentation to a series of openings or passages through which the components having dimensions below those of the openings or passages pass while those having dimensions greater than those of the passages or openings do not pass through.

Subclass 233 is distinguished from subclass 659, however, in that subclass 233 is not intended to include the sorting of food articles such as fruits and vegetables. Those articles are more properly classified in subclass 659. It is not clear, therefore, on what basis the Examining Attorney classified

*Election in Response to Restriction Requirement
and Request for Reconsideration*

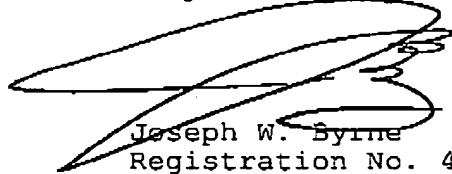
Page 9 of 10

Patent Application
Attorney Docket No.: 25092-13

the Group II and IV inventions under subclasses 369 and 288 respectively. Each of those groups would appear to be more properly classified under subclass 659, the same subclass under which Groups I and II are indirectly classified. Thus, all four of the grouped inventions appear to be more properly classified, directly or indirectly, under subclass 659.

In view of the foregoing, the Applicant respectfully requests that the restriction requirement be withdrawn upon reconsideration, or in the alternative, if not withdrawn, that it be modified in accordance with the foregoing.

Respectfully submitted,



Joseph W. Byrne
Registration No. 43,522

Dated: February 27, 2004

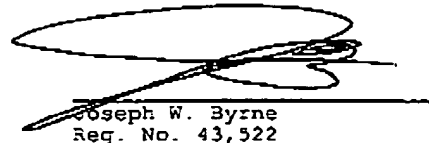
BOARDMAN, SUHR, CURRY & FIELD LLP
1 South Pinckney Street, Fourth Floor
P.O. Box 927
Madison, WI 53701-0927
Phone: 608-257-9521
Fax: 608-283-1709

GPFDesktop\::ODMA\WORLD\OX\F:\DOCS\WD\25092\13\RESP1.WPD

CERTIFICATE OF TRANSMISSION BY FACSIMILE
(37 C.F.R. §1.8(a))

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on February 27, 2004.

Date: February 27, 2004



Joseph W. Byrne
Reg. No. 43,522

Election in Response to Restriction Requirement
and Request for Reconsideration

Page 10 of 10